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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,298	12/04/2003	Gregory Ervin Balcome	ROC920030259US1	7929

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EXAMINER

GILL, ERIN M

ART UNIT PAPER NUMBER

2881

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,298

Applicant(s)

BALCOME ET AL.

Examiner

Erin-Michael Gill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. US Patent No. 4745297 (hereafter '297) in view of Hefti, US Patent Application Publication Number 20030032067 (hereafter '067).

4. Regarding claims 1, 4, 7, 10, 13, '297 teaches a method for implementing enhanced examination of multiple samples comprising the steps of providing a circular metal plate including a plurality of through holes arranged in a predefined pattern (Figure 3 reference number 11), a mounting opening (figure 5 reference number 17), and inserting a plurality of sample holders, each within a selected one of said through holes (claim 1 limitation (d)).

However, '297 fails to teach an O-ring receiving recess extending within said metal plate to said

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plurality of through holes and installing an O-ring within said O-ring receiving recess to provide a secure mounting of said plurality of sample holders.

5. '067 figure 3A reference number 320 teaches an O-ring receiving recess extending within a metal plate to said plurality of through holes, reference number 350a and 350b, and installing an O-ring within said O-ring receiving recess to provide a secure mounting of said plurality of sample holders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the sample securing apparatus of '067 into the '297 sample holder because for the purpose of securing a sample, employing an o-ring securing apparatus provides stable frictional support.

6. Regarding claims 2 and 9, '297 figure 4 reference number 24 teaches the step of mounting said metal plate to a stage holder', said stage holder having an upper portion extending above a base portion, and said upper portion inserted into said mounting opening of said metal plate.

7. Regarding claims 3, 8 and 14 '297 teaches a method and apparatus of claims 1 and 7 except for said circular metal plate being formed of aluminum. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the plate of aluminum, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

8. Regarding claims 5 and 11, '297 figure 5 teaches the circular metal plate including a plurality of through holes arranged uniformly spaced apart along a common diameter.

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9. Regarding claims 6 and 12, '067 figure 3a reference number 318, o-ring cavity, has a diameter less than that of reaction vessel 310, thus teaching said o-ring having a diameter less than the common diameter.
10. Regarding claims 15 and 16, '297 in view of '067 discloses the claimed invention except for the specific diameters. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the metal plate have a diameter of about 3 inches and said plurality of through holes be arranged along a common diameter of about 2 inches, since such a modification would have involved a mere change in size of a component, in this case the plate and common diameters. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erin-Michael Gill whose telephone number is 571-272-2471. The examiner can normally be reached on M-F (8:30-5:00 EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee can be reached on 571-272-2477. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EMG


NIKITA WELLS
PRIMARY EXAMINER 07/26/04